

REMARKS

The Applicant has carefully reviewed the Office Action dated September 5, 2007. Claims 51-70 are all the claims pending in this application. Claims 51, 53, and 64 are amended. No new matter is added. It is submitted that the application as submitted is in condition for allowance. Reexamination and reconsideration of the application is respectfully requested.

Claims 51-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 53 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 51-70 are rejected as being unpatentable over Uyehara et al. (U.S. 6,154,214) in view of Register (U.S. 5,661,632). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

§112 Rejections:

Claims 51-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

On page 14 of the Office Action, the Examiner contends that the specification does not describe the recited language related to (1) “at least one of a first length and a second length of the second image is adjusted in size so that the second image is displayed in entirety in the first display area of the display screen” (2) “wherein the first and second display areas are non-overlapping” and (3) “wherein the first image and the second image have approximately same aspect ratio.” The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP 2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Referring to the specification paragraphs 0027 and 0028, of the present application, a reasonable person reviewing the entire disclosure would clearly find that the applicant at the time of filing of the application was in possession of (and disclosed both explicitly and implicitly) the claimed features of “the first and second display areas are non-overlapping,” as recited in claim 51.

Contrary to the statements made in the Office Action, §112, first paragraph does not require a word-for-word matching between the language in the specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s understanding, then the claim language would have to be limited to *identical* language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.”

The application as filed supports the rejected claim language. Paragraph 0027 states that the length D corresponds to length A squared divided by length B. As shown in Fig. 3 and described in paragraph 0024, length B is longer than width A. Therefore, in the embodiment recited in paragraph 0024 and the formula recited in paragraph 0028, if length B is greater than length A, then length D will be less than length B. Additionally, paragraph 0028 recites that “an

empty space may be generated on the lower end of the image on the display unit 103, as a result of adjustments made to the image's dimensions." Applicant submits that since length D will be less than length B, given the formula of D equals A squared divided by B, the empty space rendered on the lower end of the image is exclusive of the image and can be construed as a second display rendered as the lower end of the image on the display unit 103. A first display area is construed as rendered above the empty space, wherein the image is displayed. Therefore, a person of ordinary skill in the art, reviewing the specification and the drawings, no doubt, would understand that the "empty space" generated "on the lower end of the image on the display unit" can be construed as a second display area.

An image that is rotated 90 degrees cannot maintain the same length and width on a screen that has length and width that are different than the rotated image. Therefore, the rotated image will contain some empty space on either the top or bottom. Since the rotated image will contain empty space, the Applicant does not follow the Examiner's reasoning why any further support is needed for what is inherent in the meaning of a non-overlapping second display area. It is respectfully submitted that the specification discloses that the "the first and second display areas are non-overlapping" as recited in claim 51.

Examiner contends that claim 52 fails to comply with the enabling requirement of 112, first paragraph because paragraphs 0024-0027 of the specification recite that "the aspect ration of the second image is different from the aspect ration of the first image." Applicant respectfully disagrees. Claim 52 recites that "the first image and the second image have approximately same aspect ratio." Paragraph 0027 states that "in case that the image of the display unit 103 is rotated by approximately 90°, as shown in FIGS. 3B and 3C, the aspect ratio of the display unit 103 is changed from A:B to C:D in order to prevent the image from being distorted."

Applicant submits that changing an aspect ration from A:B to C:D is not the same as having a different aspect ratio. For example, a common aspect ratio for photographs is 4:3. The 4:3 aspect ratio is derived from the 1.33:1 aspect ratio. Therefore, an image can have the dimensions of 4:3, 2.66:2, 1.33:1, and still contain the same aspect ratio, even though the values

have been changed. It is respectfully submitted that the specification discloses that the “first image and the second image have approximately same aspect ratio,” as recited in claim 52.

With respect to claim 51 reciting “at least one of a first length and a second length of the second image is adjusted in size so that the second image is displayed in entirety in the first display area of the display screen,” claim 51 has been amended to more fully claim the features related to the first and second lengths of the second image when displayed in the first display area of the display screen. Applicant submits that the amendment to claim 51 overcomes the §112, first paragraph rejection by reciting at least one of a first length and a second length of the second image are adjusted in size so that the second image is displayed in entirety in the first display area of the display screen.”

Finally, claims 57 and 64 recite “at least one of” the width and height of the “second image is adjusted in size for the second image to be displayed in a first display area of the display screen so that the second image has approximately same aspect ratio as the first image.” Claims 57 and 64 have been amended to more particularly claim the features related to the first and second lengths of the second image being adjusted to have approximately the same aspect ratio as the first image. Applicant submits that the amendments to claims 57 and 64 overcomes the §112, first paragraph, rejections.

Respectfully, the Examiner has misinterpreted the requirements of §112 in rejecting the claims. Pursuant to MPEP §2163 (II) (A) and §2163.04, the Examiner is requested to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims,”¹ or otherwise withdraw the rejection.

¹ MPEP § 2163.04 “If applicant ... points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”).

Claims 53 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner contends that claim 53 recites “the first length of the second image is approximately equal to a first length of the display screen, and the second length of the second image is approximately equal to square of the first length of the display screen divided by a second length of the display screen.” Examiner further contends that claim 53 is contradicted by the limitation of claim 52 which recites “first image and the second image have approximately same aspect ratio.” Applicant respectfully disagrees.

Applicant has demonstrated above how the aspect ratio can remain the same even though the dimensions of an image may change. Applicant respectfully submits that elements recited in claim 53 do not contradict the elements recited in claim 52. Although claim 53 changes the dimensions of the second image, the aspect ratio is still approximately the same as that of the first image.

For example, as previously stated, a common aspect ratio for photographs is 4:3. The 4:3 aspect ratio is derived from the 1.33:1 aspect ratio. Therefore, an image can have the dimensions of 4:3, 2.66:2, 1.33:1, and still contain the same aspect ratio, even though the values have been changed. Thus claim 53 should be allowable. Claim 60 should be allowable for the same reasons discussed in regards to claim 53. For the above reasons, Applicant respectfully requests that the 112 grounds of rejection under both the first and the second paragraph to be withdrawn.

§103 Rejections:

Claims 51-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyehara in view of Register.

As amended, claim 51 recites a method of controlling image display on a hand-held mobile communication terminal, the method comprises “displaying a second image in a first display area of the display screen, in response to a user interacting with the mobile

communication terminal to affirmatively control at least a first and a second direction of rotation for an image displayed on the display screen, wherein the second image comprises a rotated version of the first image relative to the display screen, wherein a width and a height of the second image is adjusted in size so that the second image is displayed in entirety in the first display area of the display screen.”

On page 18 of the Office Action, the Examiner contends that due to the 112 rejection, the elements of claim 51 are given the broadest reasonable interpretation and Figs. 17-18 teach “wherein at least one of a first length and a second length of the second image is adjusted in size so that the second image is displayed in entirety in the first display area of the display screen.” Applicant respectfully disagrees.

It is respectfully submitted that, Figs. 17-18 do not disclose all of the elements of claim 51. Fig. 17 of Uyehara, discloses text displayed on a mobile device. Specifically, the last line of the text shows “places is built upon the idea of a virtual meeting place – a space on the.” Fig. 18 of Uyehara, also discloses text displayed on a mobile device. Specifically, the last line of text shows “places is built upon the idea of a virtual meeting place – a space on the desktop where users can share information and.” (Emphasis Added).

Applicant submits that Fig. 18 displays seven words which are not displayed in Fig. 17. Specifically, Fig. 18 displays the words “desktop where users can share information and.” Therefore, as shown in Figs. 17-18, Uyehara does not teach “the second image comprises a rotated version of the first image relative to the display screen, wherein a width or a height of the second image are adjusted in size so that the second image is displayed in entirety in the first display area of the display screen” as recited in claim 51.

Regardless of whether Fig. 17 is considered the first or second image, Figs. 17-18 do not show the same image displayed in entirety, because the text displayed in Fig. 18 contains more words than the text displayed in Fig. 17. Thus, Uyehara does not teach “wherein the second image comprises a rotated version of the first image relative to the display screen, wherein a

width or a height of the second image are adjusted in size so that the second image is displayed in entirety in the first display area of the display screen,” as recited in claim 51.

Additionally, since Fig. 18 displays more words than Fig. 17, Uyehara does not teach the “second image has approximately same aspect ratio as the first image,” as recited in claims 57 and 64. A second image that has approximately the same aspect ratio as the first image will not cause words to be added or deleted to the image. Images with the same aspect ratio may vary in height and width, however, the images’ content does not change. Therefore, Uyehara does not teach “second image has approximately same aspect ratio as the first image,” as recited in claims 57 and 64. For the reasons stated above, Uyehara does not teach all of the elements recited in amended claims 51, 57, and 64.

Referring to the secondary reference Register, Register teaches a handheld computer that selectively rotates, “through an angle of 90 degrees, the orientation of data generated on the screen so that in either of the first and second housing use orientations the screen data is in an upright viewing orientation relative to the user of the computer.” (Register, Abstract). Applicant submits that Register does not cure the stated deficiencies of Uyehara with respect to “the second image comprises a rotated version of the first image relative to the display screen, wherein a width or a height of the second image are adjusted in size so that the second image is displayed in entirety in the first display area of the display screen” as recited in claim 51. Accordingly, even if one of ordinary skill were to combine these references in the manner alleged, the resulting system would not teach all of the elements of independent claims 51, 57, and 64.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have

suggested the claimed subject matter to a person of ordinary skill in the art.’ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.” (citations omitted).

It is well-settled law that to support a finding of obviousness, a reference must provide some motivation, working without the benefit of the applicant’s specification, to make the necessary changes in the device disclosed in the reference. The mere fact that a worker in the art could modify the reference to meet the terms of the claims is not, by itself, sufficient. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

Therefore, it is respectfully submitted that claims 51, 57, and 64 are allowable over the cited references. Additionally, dependent claims 52-56, 58-63, and 65-70 are allowable by virtue of their dependence to the allowable independent claims.

Conclusion

In light of the above remarks, Applicant submits that the present Amendment places all claims of the application in condition for allowance. Reconsideration of the application is requested.

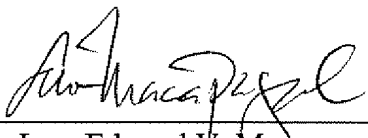
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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